

Appl. No. 10/738,430  
Examiner: BALAOING, ARIEL A, Art Unit 2617  
In response to the Office Action dated January 11, 2007

Date: April 4, 2007  
Attorney Docket No. 10113501

## **AMENDMENTS TO THE DRAWINGS**

The attached one (1) sheets of drawings include changes to Figure 5a. Replacement Sheet 1 replaces the original sheet for Figures 5a-5c.

Attachment: Replacement Sheets (1)

## **REMARKS**

Responsive to the Office Action mailed on January 11, 2007 in the above-referenced application, Applicant respectfully requests amendment of the above-identified application in the manner identified above and that the patent be granted in view of the arguments presented. No new matter has been added by this amendment.

### Present Status of Application

Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi et al (US 2002/0094841, hereinafter "Sakaguchi") in view of Learmonth et al (US 6,075,706, hereinafter "Learmonth"). Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Learmonth and in further view of Kao et al (US 2003/0227763, hereinafter "Kao"). Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Learmonth and in further view of Ito et al (EP 0 947 944, hereinafter "Ito").

In this paper, new claims 22-23 are added reciting, *inter alia*, that the sliding holder comprises an inclined surface. Support for the new claims can be found at least in original Fig. 5a and the related description. The specification and figures are amended accordingly. Thus, on entry of this amendment, claims 1-23 remain in the application.

Reconsideration of this application is respectfully requested in light of the amendments and the remarks contained below.

### Rejections Under 35 U.S.C. 103(a)

Claims 1-4, 6-11, 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Learmonth. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Learmonth and in further view of Kao. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakaguchi in view of Learmonth and in further view of Ito. Applicant respectfully traverses the rejections for the reasons as follow.

Claim 1 recites, *inter alia*, a sliding holder disposed in a first concave portion of a body, the holder slideable between a first position overlapping a second concave portion and a second position not overlapping the second concave portion. A SIM card is removably disposable in the second concave portion of the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position during the disposition of the SIM card in the second concave portion, and the holder returns from the second position to the first position so as to fix the SIM card in the second concave portion when the SIM card is located in the second concave portion.

Similarly, claim 10 recites, *inter alia*, a sliding holder disposed on a body, the holder slideable between a first position and a second position. A SIM card is removably disposable on the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position so as not to overlap the SIM card during disposition of the SIM card on the body, and the holder returns from the second position to the first position to overlap the SIM card so as to fix the SIM card on the body when the SIM card is located on the body.

#### Claim 1-19

The rejections of claims 1 and 10 rely on a combination of Sakaguchi and Learmonth. In particular, the Examiner identifies Learmonth's teaching of sheet metal lid 26 as the alleged "sliding holder" of claims 1 and 10. For the reasons discussed in detail below, Applicant submits that 1) there is no motivation to combine the references in the manner suggested by the Examiner; and 2) even when combined, the cited references fail to teach or suggest all of the limitations of independent claims 1 and 10.

#### 1) There is no motivation to combine the references in the manner suggested by the Examiner.

Sakaguchi teaches a SIM card mounting structure including a pressing portion 3. Pressing portion 3 is described as being integrally formed with the body of the mobile phone and serving the function of a leaf spring for elastically pressing the SIM card 1 into the receiving recess 5. Page 2, paragraph 0028. Furthermore, in paragraph 0029 Sakaguchi teaches:

In this manner, according to the SIM card mounting structure of the present invention, an effect similar to that obtainable by the conventional SIM card mounting structure can be obtained without using any separately prepared part and the confirmation of the mounting state of the SIM card and the demounting of the SIM card can be performed easily.

It is well established that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Also see MPEP 2143.01. In said decision, the court held the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

Applicant submits that the modification proposed in the rejections would change the principle of operation of the prior art invention being modified. Namely, the basic principle of Sakaguchi is the use of an integrally formed leaf spring to guide insertion and removal of the SIM card, confirm mounting of the SIM card, and maintain electrical contact between the SIM card and the body of the mobile phone. This is evident throughout paragraphs 0026-0032 of the references (i.e., the entire detailed description). Substitution or modification of this element such that it included the relevant features of sheet metal lid 26 of Learmonth would require a complete reconstruction and redesign of this element in a manner contrary to the basic principle of Sakaguchi's teaching.

For at least this reason, Applicant submits that there is no motivation to combine Sakaguchi and Learmonth in the manner suggested by the Examiner. Withdrawal of rejections 1-21 is respectfully requested.

2) Even when combined, the cited references fail to teach or suggest all of the limitations of claims 1 and 10.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As noted above, Sakaguchi teaches the use of a leaf spring to guide insertion and removal of the SIM card, confirm mounting of the SIM card, and maintain electrical contact between the SIM card and the body of the mobile phone. There is no teaching or suggestion of a holder slidable between a first position overlapping a second concave portion and a second position not overlapping the second concave portion as recited in claim 1, or a holder slidable between a first position overlapping a SIM card and a second position not overlapping a SIM card, as recited in claim 10.

Learnmonth, on the other hand, teaches a sheet metal lid 26 designed to slide in grooves 28 of frame 22 between an open and closed position. In particular, it is noted that the structure of Learnmonth's device is such that the lid is opened and closed in a manner completely independent from the insertion or removal of the chip card 20. See col. 3, line 65 to col. 4, line 10. For example, to insert a chip card, a user digitally manipulates sheet metal lid 26 to an open position, and then inserts chip card 20. There is not contact between the chip card and the lid, nor would contact serve any purpose.

To the contrary, claim 1 recites a structure in which a SIM card is removably disposable in the second concave portion of the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position during the disposition of the SIM card in the second concave portion, and the holder returns from the second position to the first position so as to fix the SIM card in the second concave portion when the SIM card is located in the second concave portion. Similarly, claim 10 recites a structure in which SIM card is removably disposable on the body, wherein the SIM card is abutted by the holder so that the holder is slid to the second position from the first position so as not to overlap the SIM card during disposition of the SIM card on the body, and the holder returns from the second position

to the first position to overlap the SIM card so as to fix the SIM card on the body when the SIM card is located on the body. These features are entirely absent in the combination of Sakaguchi and Learmonth.

It is therefore Applicant's belief that even when taken in combination, the prior art references relied upon by the Examiner do not teach or suggest all the limitations of claims 1 and 10. For at least this reason, a *prima facie* case of obviousness cannot be established in connection with these claims. Furthermore, as it is Applicant's belief that a *prima facie* case of obviousness is not established for claims 1 and 10, the Examiner's arguments in regard to the dependent claims are considered moot and are not addressed here. Allowance of claims 1-21 is respectfully requested.

#### Claim 20-21

Claim 20 recites that the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic member corresponding to the abutting surface, wherein the elastic member is compressed against the abutting surface by movement of the holder from the first position to the second position, and elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position.

Similarly, claim 21 recites that the body includes an abutting surface between the first concave portion and the second concave portion, and the holder includes an elastic member corresponding to the abutting surface, wherein the elastic member is compressed against the abutting surface by movement of the holder from the first position to the second position, and elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position.

First, Applicant submits that claims 20 and 21 are allowable by virtue of their dependency from claims 1 and 10, respectively.

Second, Applicant contends that the Examiner has essentially listed certain elements of the present invention and then located isolated disclosures of those components. Namely, Sakaguchi describes a card holder implementing an integral leaf spring. Learmonth, on the other hand, describes a card holder implementing a separate digitally manipulated sliding cover. The rejections now seek to combine these already conflicting disclosures with a card holder implementing a hinged cover. It is the Applicant's belief that the present rejection fits the Federal Circuit's description of an impermissible rejection under §103. Namely, in *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), the Federal Circuit stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior so that the claimed invention is rendered obvious. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (quoting *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600).

There appears to be no motivation for combining separate elements and/or features of three conflicting implementations of a card holder (integral spring leaf, separate sliding cover, hinged cover) other than to recreate Applicant's invention using the claims as a template.

Third, Applicant notes that the rejections of claim 20-21 rely on Ito to teach certain limitations of the claims. Applicant respectfully submits that the rejections mischaracterize the teaching of Ito, and furthermore that the references as combined do not teach all the limitation of claim 20-21.

Ito teaches a hinged card reader connector. The rejections appear to identify leaf spring 29 and flat surface 11 of Ito as the alleged elastic member and abutting surface of the claims. In particular, the Examiner asserts that Ito teaches "... an abutting surface between the first concave portion and the second concave portion (Figure 1; paragraph 17-19), and the holder includes an elastic member corresponding to the abutting surface (leaf spring; abstract; paragraph 20-21), wherein the elastic member is compressed against the abutting surface by movement of the holder from the first position to the second position (paragraph 20-21), and the

elastic force from the compressed elastic member returns the holder from the second position to the first position when the holder is released while in the second position (paragraph 20-21; cover slides and locks, when released the cover is forced into the second position via the leaf elasticity)." Pages 9-10 of the Office Action.

Referring to paragraphs 0017-0021 of Ito, however, Applicant notes that there is absolutely no reference to the elastic member's (leaf spring) interaction with other elements as stated in the Office Action. To the contrary, the leaf spring 29 is described in detail in paragraphs 0024-0028.

Furthermore, it is noted that leaf spring 29 is not compressed against the alleged abutting surface by movement of the cover from a first position to a second position as defined in the claims. To the contrary, leaf spring 29 is biased as the cover enters into the locked position. See paragraph 0025 of Ito. This is a horizontal sliding with the alleged "holder" and base remaining at all times in a overlapping arrangement. In addition, the elastic force from the compressed leaf spring 29 does not return the holder from a second position to a first position as defined in the claim when the cover is released while in the second position. See paragraph 0027 of Ito. To the contrary, on the unlocking of the SIM card, the elastic force presumably moves the cover slightly in a horizontal direction while at all times maintaining the overlapping arrangement with the SIM card and base. Thus, in the Ito arrangement, the alleged holder is never moved from an overlapping to a non-overlapping position and back via compression of the spring. Furthermore, the unlocking of the SIM card movement (i.e., the return force from compressed elastic member) in fact releases the SIM card, it does not fix the SIM card as recited in the claims.

In short, Ito simply discloses an elastic member and an abutting surface. The actual arrangement of these elements as recited in the claims is not disclosed. For at least the above reasons, Applicant submits that claims 20-21 are allowable over the cited art.

New Claims 22-23

New claim 22 recites that the sliding holder comprises an inclined surface, wherein an obtuse angle is formed between the inclined surface and the first concave portion, and the SIM card is abutted by the inclined surface of the holder so that the holder is slid to the second position from the first position during the disposition of the SIM card in the second concave portion.

New claim 23 recites that the sliding holder comprises an inclined surface, wherein an obtuse angle is formed between the inclined surface and the body, and the SIM card is abutted by the inclined surface of the holder so that the holder is slid to the second position from the first position so as not to overlap the body during the disposition of the SIM card on the body.

Applicant submits that claims 22 and 23 are allowable by virtue of their dependency from claims 1 and 10, respectively. In addition, Applicant submits that neither Sakaguchi nor Learmonth describe that the sliding holder comprises an inclined surface. Furthermore, neither reference teaches or suggests that an obtuse angle is formed between the inclined surface and the first concave portion (or body). Finally, neither reference teaches or suggests that the SIM card is abutted by the inclined surface of the holder so that the holder is slid to the second position from the first position during the disposition of the SIM card in the second concave portion (or to the second position from the first position so as not to overlap the body during the disposition of the SIM card on the body).

For at least these reasons, Applicant submits that claims 22-23 are allowable over the cited art.

Conclusion

The Applicant believes that the application is now in condition for allowance and respectfully requests so. The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to Deposit Account No. **502447**.

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